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08/726,024	10/04/1996	DANIEL A. HENDERSON		8599

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EXAMINER

ANWAH, OLISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/726,024

Applicant(s)

HENDERSON, DANIEL A.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-222 is/are pending in the application.
- 4a) Of the above claim(s) 1-191 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 192-222 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 192-195, 197, 199, 200, 203, 208-212, 217, 218 and 220 are rejected under 35 U.S.C. § 102(e) as being anticipated by Davis, U.S. Patent No. 4,942,598 (hereinafter Davis).

Regarding claim 192, Davis discloses a method of communicating information, from a calling party using a telephone (400) connected to a telephone network (405) that automatically provides caller identification information, to a called party having a portable communication device (420) that is pageable by a paging network (415) in communication with a telephone answering apparatus (410), such telephone answering

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apparatus in communication with the telephone network, the method comprising:

receiving at the telephone answering apparatus caller identification information, pertinent to the telephone of the calling party, provided automatically by the telephone network (see column 9, lines 60-68);

transmitting the caller identification information from the telephone answering device to the paging network (see column 10, lines 1-20); and

transmitting the caller identification information from the paging network to the portable communication device (see column 10, lines 25-35 and lines 30-36 of column 1).

Regarding claim 193, see Figure 5.

Regarding claim 194, see lines 1-30 of column 2.

Regarding claim 195, see lines 1-30 of column 2.

Regarding claim 197, see lines 1-30 of column 2.

Regarding claim 199, see lines 1-15 of column 11.

Regarding claim 200, see lines 1-15 of column 11.

Regarding claim 203, see lines 1-15 of column 11.

Regarding claim 208, see Figures 3A and 3B.

Regarding claim 209, see Figures 3A and 3B.

Regarding claim 210, see lines 30-36 of column 1.

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Regarding claim 211, see lines 30-36 of column 1.

Regarding claim 212 see Figure 5.

Regarding claim 217, see Figure 5.

Regarding claim 218, see Figure 5.

Regarding claim 220, see lines 30-45 of column 10.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 219 is rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of May, U.S. Patent No. 5,043,721 (hereinafter May).

Regarding claim 219, Davis does not state the pager is a two-way communication device. May discloses a portable pager device that is capable of two-way communications (see lines 58-65 of column 5 and lines 51-53 of column 6). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis to include the two-

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way communication capabilities as taught by May. This modification would have improved the flexibility of Davis by enabling the page-receiving user to send messages from the page-receiving device.

5. Claims 213-215 are rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of Wohl et al, U.S. Patent No. 5,247,700 (hereinafter Wohl).

Regarding claim 213, Davis teaches storing the caller identification information within the portable communication device (see 420). Davis fails to teach initiating a new connection over a cellular telephone network by transmitting the stored caller identification data to the cellular telephone network. Nonetheless, Wohl shows this feature (see Figure 1). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the compact unitary cellular/pager of Wohl. This modification would have improved the efficiency of Davis by eliminating frequency scanning and conserving energy as suggested by Wohl.

Regarding claim 214, Davis does not teach the telephone network is a cellular communication network and the portable

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communication device comprises a combined cellular telephone device and pager device. However Wohl discloses these limitations (see Figure 1). And so, it would have obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the compact unitary cellular/pager of Wohl. This modification would have improved the efficiency of Davis by eliminating frequency scanning and conserving energy as suggested by Wohl.

Regarding claim 215, Davis does not teach the paging network transmits the caller identification information to the portable communication device utilizing the cellular communication network. Nonetheless, Wohl shows this feature (see Figure 1). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the compact unitary cellular/pager of Wohl. This modification would have improved the efficiency of Davis by eliminating frequency scanning and conserving energy as suggested by Wohl.

6. Claims 201 and 204 are rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of Parvelescu et al, U.S. Patent No. 6,002,719 (hereinafter Parvelescu) (Note this

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reference is used because it is believed that this subject matter is not of record in the provisional application).

As per claim 201, Davis fails to teach compressing the optional data prior to transmission of the optional data to the portable terminal. Regardless, Parvelescu shows this feature (see column 1, line 7 to column 2, line 12). Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the transmitter of Parvelescu. This modification would have improved the efficiency of Davis by maximizing bandwidth utilization as suggested by Parvelescu.

Claim 204 is rejected for the same reasons as claim 201.

7. Claims 202, 205 and 216 are rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of Owen, U.S. Patent No. 5,483,595 (hereinafter Owen).

Regarding claim 202, Davis fails to teach encrypting the optional data prior to transmission of the optional data to the portable communication device. However Owen teaches the claimed encrypting limitation (see column 6, line 46 to column 7, line 7). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the encrypting mechanism of Owen. This

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modification would have improved the reliability of Davis by sending secure messages as suggested by Owen.

Claim 205 is rejected from the same reasons as claim 202.

Regarding claim 216, Davis discusses indicating to the called party that a message has been received (see column 1, line 36). Davis further teaches providing voice signals (the received message) representative of the caller identification data to the called party (see lines 30-45 of column 10). Nowhere does Davis mention accepting a password entered by the called party into the portable communication device and providing the received message only upon entry of a valid password. All the same, Owen discloses this feature (see Figures 3-7). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the encrypting mechanism of Owen. This modification would have improved the reliability of Davis by sending secure messages as suggested by Owen.

8. Claims 206, 207, 221 and 222 are rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of De Luigi et al, U.S. Patent No. 5,418,529 (hereinafter De Luigi).

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On the subject of claim 206, Davis is silent as to storing the caller identification and the optional data in contiguous memory locations in the portable communication device. However De Luigi shows this feature (see column 2, line 58 to line 19 of column 3). And so, it would have been obvious to one of ordinary skill in the art to modify Davis to include the memory management technique taught by De Luigi. This modification would have improved the efficiency of Davis by reducing storage requirements as suggested by De Luigi.

On the subject of claim 207, Davis is silent as to storing the caller identification and the optional data in associated non-contiguous memory locations in the portable communication device. However De Luigi shows this feature (see column 2, line 58 to line 19 of column 3). And so, it would have been obvious to one of ordinary skill in the art to modify Davis to include the memory management technique taught by De Luigi. This modification would have improved the efficiency of Davis by reducing storage requirements as suggested by De Luigi.

Claim 221 is rejected for the same reasons as claim 206.

Claim 222 is rejected for the same reasons as claim 207.

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9. Claim 198 is rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of Baehr et al, U.S. Patent No. 4,961,216 (hereinafter Baehr).

Regarding claim 198, Davis fails to teach obtaining verification from the calling party prior to transmitting the caller identification information to the paging network. However Baehr discloses this step (see column 3, lines 30-65).

Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the verification of Baehr. This modification would have improved the user friendliness of Davis by allowing the caller to specify a severity code as suggested by Baehr.

10. Claim 196 is rejected under 35 U.S.C § 103(a) as being unpatentable over Davis in view of Hotto, U.S. Patent No. 5,410,541 (hereinafter Hotto).

With respect to claim 196, Davis does not teach the caller identification information is provided as FSK data. However Hotto discloses this limitation (see abstract). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis with the encoding method of Hotto. This modification would have improved the efficiency of Davis by maintaining the maximum possible

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fidelity of an analog signal traversing an analog channel while providing error free data communications during spurious intervals without muting the analog signal as suggested by Hotto (see lines 40-45 of column 2).

Response to Arguments

11. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

OA

Olisa Anwah
Patent Examiner
February 22, 2006



FAN TSANG
SUPERVISORY PATENT EXAMINER
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